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09/493,526

01/28/2000

Ofir Shalvi

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EXAMINER

CORRIELUS, JEAN B

ART UNIT

PAPER NUMBER

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PAPER

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**GROUP 2600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/493,526  
Filing Date: January 28, 2000  
Appellant(s): SHALVI ET AL.

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Carlton H. Hoel  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the supplemental appeal brief filed November 01, 2006  
appealing from the office action mailed April 05, 2005.

**Examiner's comment**

Note that the following supplemental examiner's answer supersedes the communication filed 12/27/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,151,296

Vijayan et al.

11-2000

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Vijayan et al. US patent No. 6,151,296.

As per claim 1, Vijayan et al discloses a transmitter (fig. 2) comprising a convolutional encoder 26 for receiving data values; said encoder 26 coupled to (concatenated with) an outer Reed-Solomon encoder 22 (see abstract); a bit-interleaver 28 interconnected with the convolutional encoder 26; a symbol mapper 32 interconnected with said bit interleaver 28. (Note that the limitation "for a CATV upstream data channel transmitter" is not given any patentable weight because it is only included in the preamble).

As per claim 2, the mapper 32 is a QAM Mapper see fig. 2.

As per claim 3, Vijayan et al further teaches a receiver fig. 3 having element 40 corresponding to the claimed scorer for receiving symbols; a bit deinterleaver 50 see col.6, lines 48-51 interconnected with element 40 corresponding to the claimed scorer and a convolutional decoder 52 interconnected with said bit deinterleaver 50.

(Note that the limitation “for a CATV upstream data channel transmitter” and “for a CATV upstream data channel receiver”, as recited in claim 3, are not given patentable weight as such limitations are merely intended use).

#### **(10) Response to Argument**

Applicant's arguments filed 11/01/06 have been fully considered but they are not persuasive. In response to applicant's arguments, the recitation “for a CATV upstream transmitter”, recited in claim 1, has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument, with respect to claim 3, that Vijayan provides a coding for a wireless system rather than a CATV system and that coding in Vijayan is to counter multipath fading problems of wireless systems while a cable system has no fading problems rather impulse burst noise problems, a recitation of the

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intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

However, for the sake of argument, contrary to the applicant's position that CATV system has no fading but rather impulse and burst noise problems, it is well known in the art that "fading or multipath" is a drawback in both wireless and CATV systems. See for instance, Ghosh et al, US patent No. 5,881,363, abstract and drawing figs. 1-2 that clearly show a fading CATV channel between the Head end 14 and users 12.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

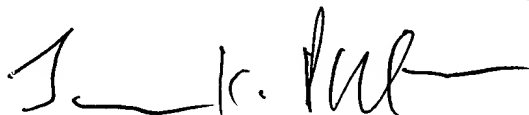


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Art Unit 2611 1-08-07

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